

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Consolidated Specialty Restaurants, Inc.	:	BEFORE THE
Trademark:	COLORADO STEAKHOUSE and design	:	TRADEMARK TRIAL
Serial No:	75/857797	:	AND
Attorney:	Scott J. Stevens	:	APPEAL BOARD
Address:	Woodard, Emhardt, Naughton, Moriarty & McNett Bank One Center/Tower 111 Monument Circle, Suite 3700 Indianapolis, Indiana 46204-5137	:	ON APPEAL

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MAR 10 2003

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark "COLORADO STEAKHOUSE" and design for "restaurant services" on the grounds that the mark is geographically deceptively misdescriptive under Trademark Act Section 2(e)(3).

**I. FACTS**

On November 24, 1999, the applicant applied for registration on the Principal Register for the mark "COLORADO STEAKHOUSE" and design for "restaurant services." Registration was refused under Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3), because the mark is geographically deceptively misdescriptive of the services. The applicant responded by arguing against the refusal and claiming that the mark "has acquired distinctiveness through its substantially continuous and exclusive use of the mark in commerce." *Applicant's Response of October 23, 2000*, p. 5. In a second office action, the examining attorney refused to register the mark based on Section 2(f)

because a mark is registrable upon a showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), only if it became distinctive of the goods or services in commerce before December 8, 1993, the date of the enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. In the alternative, the examining attorney issued the requirement for a disclaimer of the words COLORADO STEAKHOUSE if the services originate in Colorado. On March 8, 2002, the refusal of the mark as geographically deceptively misdescriptive under Trademark Act Section 2(e)(3) was made Final.

## **II. OBJECTION TO EVIDENCE**

The evidence submitted by the applicant with its Brief in Support of Appeal is untimely and therefore cannot be considered. The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d). The new evidence which the applicant has attempted to introduce should be excluded from the record. TBMP §§1207.01 *et seq.* See *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960).

## **III. ARGUMENT**

### **THE MARK OF THE APPLICANT IS GEOGRAPHICALLY DECEPTIVELY MISDESCRIPTIVE OF THE APPLICANT'S SERVICES.**

The single issue on appeal is whether the applicant's mark "COLORADO STEAKHOUSE" and design is geographically deceptively misdescriptive of "restaurant services."

A mark is primarily geographically deceptively misdescriptive of services if it identifies a place other than the place where the services originate. To support a refusal to register a mark as primarily geographically deceptively misdescriptive, the following criteria must be met:

- (1) the primary significance of the mark is a generally known geographic location; and
- (2) purchasers would be likely to make a services/place association; and
- (3) the services do not originate in the place identified in the mark.

*In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

**A) PRIMARY SIGNIFICANCE OF THE MARK IS GEOGRAPHIC.**

The applicant's mark is a composite mark which combines the geographically deceptively misdescriptive word "COLORADO" with the descriptive word "STEAKHOUSE" and a design element which includes the silhouette of a mountain range. A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning. In the office action of April 21, 2000, the examining attorney submitted a definition of the word "COLORADO" which reads "a state of the west-central United States." *The American Heritage Dictionary of the English Language, Third Edition* (1992). The primary significance of the word "COLORADO" is geographical. The primary significance of

the mark as a whole is likely to be perceived as indicating the geographic origin of the services. Moreover, the additional matter in the mark does not alter the geographic significance of the mark. The word "STEAKHOUSE," which has been disclaimed, would be perceived as merely informational in connection with the services and does nothing to alter the primary geographic significance of the mark. Furthermore, the design element featuring the silhouette of a mountain range in fact reinforces the geographic significance of the mark in that Colorado is home to the well-known Rocky Mountains.

**B) A SERVICES/PLACE ASSOCIATION EXISTS**

A public association exists between the applicant's services and Colorado because purchasers are likely to believe that the services originate in Colorado. Included in the office action of March 8, 2001, was evidence that a services/place association exists between restaurant services, specifically steakhouses, and the State of Colorado. The evidence of record demonstrates that there are steakhouses in Colorado. The examining attorney attached excerpts from the websites [www.gjcolorado.com](http://www.gjcolorado.com) and [www.restauranteur.com](http://www.restauranteur.com) as evidence that a services/place association exists between restaurants and Colorado. The examining attorney also submitted evidence that Colorado is known for its steaks. The examining attorney refers to the excerpts from the websites [www.chaparralsteakhouse.com](http://www.chaparralsteakhouse.com) and [www.winterpark-info.com](http://www.winterpark-info.com) as well as the LEXIS/NEXIS articles as evidence that Colorado is known for its steaks. This evidence further bolsters the services/place association between the restaurant services and Colorado because consumers will believe that the steaks served in the applicant's restaurants originated in Colorado. The Court of Appeals for the Federal Circuit has held

- that geographic regions noted for certain products or services are likely to expand from their traditional goods or services into related goods or services. *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001). The court held that “the registrability of a geographic mark may be measured against the public’s association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there.” *Id* at 1355. Therefore, consumers dining in the applicant’s restaurants will expect that the services or the items featured on the menu originate in Colorado. The record strongly supports the conclusion that applicant’s restaurant theme, as discussed by the applicant in its responses and brief, encourages the services/place association. Therefore, an association between the applicant’s restaurant services and Colorado under Section 2(e)(3) of the Trademark Act exists.

### **C) SERVICES DO NOT ORIGINATE IN COLORADO**

Marks that are primarily geographically deceptively misdescriptive are not permitted to register because such marks mislead the public into believing that the goods or services originate in the geographic location named in the mark when in fact they do not originate in that location. The services of the applicant do not originate in Colorado. The applicant’s address is in Indianapolis, Indiana. Further, in the office action of October 28, 2002, the examining attorney highlighted the fact that the applicant’s menu indicates that all of its restaurants are in Indiana and Illinois.

The applicant has argued that its restaurant services originate in Colorado because “that is the location from which the restaurant concept originates.” *Applicant’s Response*

- *of September 10, 2001*, p. 5. The applicant continues by arguing that its restaurants include Colorado Rocky Mountain, western and Colorado ski-lodge themes and feature “décor and artwork” that furthers these themes. *ID* at 5.

The applicant’s argument that restaurant services can be said to originate from a geographic location based on a theme established by décor and artwork is without merit. Establishing atmosphere and theme with décor and artwork evoking a geographic location do not equate with the origination of the services. In fact, they further the geographically deceptively misdescriptive nature of the mark because they promote the idea that the restaurant services are in fact from Colorado. The mark is geographically deceptively misdescriptive precisely because it promotes a connection with Colorado where none in fact exists.

The applicant continues this line of argument in its Brief. The applicant states that the “style of cooking, the atmosphere, the concept, and at least some of the fixtures and decorations come from or originate in Colorado.” *Applicant’s Appeal Brief*, p. 5. As argued above, fixtures and decorations evoking Colorado do not serve to identify the geographic location from which services originate. To the contrary, decorations and fixtures suggesting a connection to a geographic location where none exists further the geographically deceptively misdescriptive nature of the mark in relation to the services.

The applicant’s argument that the mark describes a “style of cooking” is unpersuasive. The applicant must bring forth evidence demonstrating that there is “Colorado style” of the restaurant services at issue. *In re Wada*, 194 F.3d 1297, 194 USPQ2d 1539 (Fed. Cir. 1999). The applicant has not submitted any evidence that a Colorado “style of cooking” or cuisine exists. Restaurant services featuring “Chinese

food,” “Thai food,” and “Cajun cuisine” are examples of “styles of cooking.” There is nothing in the record to suggest that the geographic term COLORADO describes a style of cooking. The fact that Colorado is known for steaks is not the same as Colorado being known for a style of cooking. It means that Colorado is known for the high quality of beef produced by the cattle which graze there.

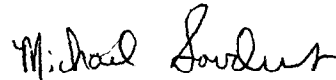
Additionally, the examining attorney notes that in its *Response after First Action* dated October 23, 2000, the applicant made a claim of acquired distinctiveness under Section 2(f) based on the “substantially continuous and exclusive use of the mark in commerce.” *Id* at 5. The claim of acquired distinctiveness was denied by the examining attorney because a mark that is primarily geographically deceptively misdescriptive may not be registered on the Principal Register under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), unless it became distinctive of the goods or services in commerce before December 8, 1993, the date of the enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. The date of first use of the mark in commerce was October 17, 1994, and is therefore not eligible for registration on the Principal Register under Section 2(f).

Based on the evidence of record, the proposed mark COLORADO STEAKHOUSE is geographically deceptively misdescriptive of the applicant’s services. The significance of the mark is primarily geographic but the services do not originate in the place named. Despite the applicant’s arguments, no evidence has been submitted indicating that the applicant’s restaurant services originate in Colorado.

#### IV. CONCLUSION

For the foregoing reasons, the refusal to registration under Section 2(e)(3) of the Trademark Act, 15 U.S.C. Section 1052 (e)(3) should be affirmed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Souders".

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